

### **REMARKS**

Claims 1-23, 51 and 52 were presented in the pending application. The Examiner has rejected claims 1-14 and 16-23 and has objected to claim 15. The Examiner has also withdrawn claims 51 and 52 from consideration.

The Examiner, in the official action, has withdrawn newly submitted claims 51 and 52 from the present application for the reasons set forth in paragraph 2 citing MPEP § 821.03 for support in doing so. Applicants respectfully submit that they be considered in the present application. In particular, in order for these claims to be withdrawn there must be a basis that the claims are independent and distinct from the claims previously recited. See MPEP § 921.03. However, the Examiner has provided no basis to illustrate that these claims are independent and distinct except to rely on the fact that Applicants have previously elected to pursue the kit claims as opposed to the original method claims. However, the original method claims, as originally submitted, were directed to a method for ordering of a kit for use in organizing images. This is in contrast to independent claims 51 and 52 which are directed to a method for organizing a plurality of the images. This is in line with independent claim 1 which is directed to a kit for organizing a plurality of images. The method of claim 51 includes all of the kit limitations set forth in independent claim 1. In particular, independent claim 51 includes providing a kit having at least one order form for ordering at least one goods or services with respect to digital images provided on a plurality of high copy prints. Claim 1 specifically includes “at least one order form for ordering at least one good and/or service”. Independent claim 51 also includes providing at least one instruction form for associating with said plurality of hardcopy prints, said at least one instruction form having machine readable code that provides information for use in organizing said images provided on said plurality of hardcopy prints. Here again, this includes all the limitations of the instruction form provided in independent claim 1. Applicants respectfully refer the Examiner to MPEP 806.05 § (e) which is directed to how distinctness can be determined in situations where claims in two different statutory categories are provided, one being an apparatus and the other being the process for practicing the apparatus. As set forth therein, “process and apparatus for its practice can be shown to be distinct inventions, if either or both of the

following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another materially different process.” In this regard, the method claim of 51 cannot be practiced by a materially different apparatus or i.e. kit as claim 51 includes all the essential elements of the independent claim 1. Likewise, the apparatus as claimed in claim 1 cannot be used to practice another materially different process. Therefore, Applicant respectfully submits that independent claim 51 is not distinct from independent claim 1 and therefore the withdrawal of these claims was improper and therefore should be examined as with the remaining claims.

The Examiner, in paragraph 3, rejected claims 1-7 under 35 USC § 103(a) as being unpatentable over Nelson et al. for the reasons set forth therein. The Examiner seems to be arguing that if the prior art structure is capable of performing the intended use, then it meets the claim. The Examiner then cites *In re Casey* and *In re Otto* in support of this position. However, Applicants respectfully submit that *In re Casey* and *In re Otto* are directed to situations apart and distinct from that of claim 1. In particular, independent claim 1 specifically recites that the form has a code capable of being machine read. Additionally, the code provides information. This information is used in organizing digital images into groups. The code is a structural part of the instruction form. The “code” is not an “intended use”. The fact that it provides information that is used in organizing digital image is the functional aspect of the code. To further illustrate that code is a structural limitation, the code is able to be scanned. Thus, the code has two important functional features. (1) it can be scanned; and (2) it provides information used in organizing the digital images. As the CAFC has said *In re Swinehart and Sfiligoj* 169 USPQ 226 (1971), the functional limitations, even at the point of novelty, must be considered. Thus, independent claim 1 provides specific structural basis and functional language in which the Examiner must consider with respect to patentability. None of the prior art cited by the Examiner illustrate the providing of a code for providing the function as taught and claimed by Applicants.

In *In re Casey* and *In re Otto* are easily distinguished from the present situation as those were directed to the use of a particular device. *In re Otto* was directed to a method of using a curling iron. The claim of the *In re Otto*

case was directed to a procedure for making a curling iron and not its use. Thus, the process involving the hair being wound around a core was irrelevant to the method of manufacturing. In the present situation, the code on the form plays an integral part of providing information for organizing the images that are used with the kit. Thus, the information becomes an integral part of the present invention. *In re Casey* was directed to a taping machine. Here again, the use of that taping machine was irrelevant to the method and manner in which the machine was used. *In re Otto* and *In re Casey* are distinct from the present invention in that the code in the present invention was designed to provide specific functional relationship with regard to the digital prints to be provided herewith. Thus, these two cases are believed not to be relevant or applicable to the present situation.

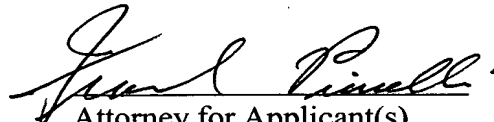
Applicants would also like to point out that the Nelson reference does not provide a plurality of hardcopy prints having images. As clearly provided in the independent claims, there is provided a plurality of images provided on a plurality of hardcopy prints. Thus, the prints referred to in the present invention are not the same as to the order form disclosed in Nelson. Thus, it is respectfully submitted that the Nelson reference is of little relevance to the present invention in that it does not teach or suggest the present invention as claimed by Applicants. It fails to deal with providing image prints, and also fails to provide a code for use in organizing prints to be used with the kit.

The Examiner also rejected claims 1-14, 16 and 21-23 under 35 USC § 103(a) as being unpatentable over Wentworth in view of Hicks and further in view of Johnson et al. However, Applicants do not clearly understand how these relate to independent claim 1 upon which claims 2-15 and 16-23 depend at least ultimately. As previously discussed in Applicants prior responses, these three references do not teach or suggest the invention as taught and claimed by Applicants. The Johnson and Wentworth references are believed to be of little relevance to the present invention. The Johnson reference is simply directed to reading forms and interpreting information thereon. There is no teaching or suggestion of providing both an order form and an instruction form for use in organizing the images that are provided in hardcopy prints as taught and claimed by Applicants. Likewise, Wentworth is nothing more than a filing system for filing household documents. The Hicks reference is simply directed to an order form for ordering prints as illustrated on the order form. There is no teaching or

suggestion of organizing any images as taught and claimed by Applicants.  
Accordingly, it is respectfully submitted that neither of these references teach or suggest the invention as taught and claimed by Applicants.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

  
Attorney for Applicant(s)  
Registration No. 27,370

Frank Pincelli/phw  
Rochester, NY 14650  
Telephone: 585-588-2728  
Facsimile: 585-477-4646